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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/728,972 | 12/08/2003 | Chih-Wei Hsieh | FP9651 | 9049 |

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EXAMINER

VERBITSKY, GAIL KAPLAN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2859

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/728,972 | Applicant(s) HSIEH, CHIH-WEI | |
| | Examiner Gail Verbitsky | Art Unit 2859 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 10221176 [hereinafter EP] in view of Zaragoza et al. (U.S.5133606) [hereinafter Zaragoza] and JP 06139869 A [hereinafter JP].

EP discloses a clinical thermometer comprising a cover/covering/ sheathing case 1 collectively/ integrally formed with a switch/ push button 7 composed of a material that is softer than the cover. The cover 1 has a sealing flange A with a skew edge B which is collectively/ integrally formed with the cover 1 and a locating groove C extended around the periphery of the rear end of the covering 1 adjacent to the sealing flange A for engagement with a sealing ring and with a cap 3 having an engagement portion inside the cap for accommodating/ engagement with the sealing flange A of the cover and with the locating groove C with the sealing ring in it.. The cover 1 covers a subcase/ inner case/ case 5 (abstract). As shown in the drawings, the cover has an outer/ peripheral wall, which is smooth. The cover is waterproof. (The numerals A-C have been added by the examiner, see attachment #1 to the Office Action).

EP does not state that the stem is a hard stem, that the cover 1 is flexible/ resilient/ soft.

Art Unit: 2859

Zaragoza discloses in Fig. 6 ab electronic thermometer comprising a flexible/resilient cover 43. The cover has a tapered front portion protruded a distance over the front side of the casing, the tapered portion having a hard stem portion A having a threaded neck to tightly connect with a metal probe 28. It is inherent, that, presence of threads makes the hard stem less flexible and thus, more rigid/ harder than the rest of the resilient cover. As shown in Fig. 6, the resilient cover 43 has two recesses, one on the top and another on the bottom. The cover is waterproof, and as shown in Fig. 6, is smooth. (The numeral A has been added by the Examiner, see attachment #2 to the Office Action).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by EP, so as to make the cover of a soft material, as taught by Zaragoza, so as to allow the probe some movement, in order to allow the operator to take measurements of a patient from different positions, and still have a comfortable grip.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by EP, so as to have a hard stem portion protruding a distance over the front side of the casing and connecting the metal probe with the rest of the thermometer, as taught by Zaragoza, so as to provide a tight connection, in order to avoid dislodgement during measurements.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to modify the device, disclosed by EP, so as to have the recesses, as taught by Zaragoza, in the top portion of the inner casing and a bottom of the inner

Art Unit: 2859

casing, so as to allow the operator to repair and install the electronic board and a display, without disassembling the inner casing, if there is a need for repair.

EP does not teach a groove around the push button 7.

JP teaches a device wherein a recess/ groove, as shown in Fig. 3 is provided around a push button, so as to better match the push button with a user finger.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device, disclosed by EP, so as to have a groove/ recess around the push button, as taught by JP, so as to allow the operator not only to see the push button, but also to feel it with his fingers, if operator holds the device in a position, when the push button is not in the operators' field of view.

With respect to "whereby"/ "thereby", as stated in claim 4: it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957).

3. Claims 5, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP in view of Zaragoza.

EP discloses a clinical thermometer comprising a cover/ sheathing case 1 collectively/ integrally formed with a switch/ push button 7 composed of a material that is softer than the cover. The cover 1 has a sealing flange A with a skew edge B which is collectively/ integrally formed with the cover 1 and a locating groove C extended around the periphery of the rear end of the covering 1 adjacent to the sealing flange A for engagement with a cap 3 having an engagement portion inside the cap for engagement with the sealing flange A of the cover. The cover 1 covers a subcase/ case 5 (abstract). As shown in the drawings, the cover has an outer/ peripheral wall, which is smooth.

Art Unit: 2859

EP does not state that the stem is a hard stem, that the cover 1 is flexible.

Zaragoza discloses in Fig. 6 ab electronic thermometer comprising a flexible/ resilient cover 43, a metal bulb/ probe connected. The cover has a hard stem/ threaded neck protruding a distance over a front side of the casing and connecting the distal end of a tapered portion of the cover 43 to a metal bulb probe 28. It is inherent, that, having threads will make the hard stem portion harder/ more rigid than the rest of the resilient cover. As shown in Fig. 6, the resilient cover 43 has two recesses, one on the top, and another on the bottom.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by EP, so as to make the cover of a soft material, as taught by Zaragoza, so as to allow the probe some movement, in order to allow the operator to take measurements of a patient from different positions, and still have a comfortable grip.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by EP, so as to have a hard stem portion protruding a distance over the front side of the casing and connecting the metal probe with the rest of the thermometer, as taught by Zaragoza, so as to provide a tight connection, in order to avoid dislodgement during measurements.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to modify the device, disclosed by EP, so as to have the recesses, as taught by Zaragoza, in the top portion of the inner casing and a bottom of the inner casing, so as to allow the operator to repair and install the electronic board and a display, without disassembling the inner casing, if there is a need for repair.

Art Unit: 2859

With respect to "whereby"/ "thereby", as stated in claim 12: it has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957).

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP and Zaragoza as applied to claims 5, 9-12 above, and further in view of JP.

EP and Zaragoza disclose the device as stated above in paragraph 3.

They do not teach a groove around the push button.

JP teaches a device wherein a recess/ groove, as shown in Fig. 3 is provided around a pushbutton, so as to better match the push button with a user finger.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device, disclosed by EP and Zaragoza, so as to have a groove/ recess around the pushbutton, as taught by JP, so as to allow the operator not only to see the push button, but also to feel it with his fingers, if operator holds the device in a position, when the push button is not in the operators' field of view.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP and Zaragoza as applied to claims 5, 9-12 above, and further in view of Frankel et al. (U.S. 4813790) [hereinafter Frankel].

EP and Zaragoza disclose the device as stated above in paragraph 3.

They do not explicitly state that the device has embossed portions as stated in claim 8.

Art Unit: 2859

Frankel discloses a device wherein symmetrical portions (embossed portions) are provided on all sides (including opposite sides) of a flexible covering for a better finger grip.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by EP, Zaragoza and JP, so as to add embossed portions, as taught by Frankel, so as to provide the user with a better grip, in order to make it easier and more convenient to hold the device.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP and Zaragoza as applied to claims 5, 9-12 above, and further in view of Takagi et al. (U.S. 4729672) [hereinafter Takagi].

EP, Zaragoza and JP disclose the device as stated above in paragraph 2.

They do not teach an inner casing made of a transparent material, as stated in claim 6.

Takagi teaches a transparent inner case 2, a transparent display window formed in the inner casing to view LCD.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device, disclosed by EP, Zaragoza and JP, so as to make the inner casing of a transparent material, as taught by Takagi, so as to provide the operator with a clear inside of the thermometer, when the cover is removed for repair of the thermometer.

Art Unit: 2859

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP, Zaragoza and JP and as applied to claims 1, 4 above, and further in view of Frankel et al. (U.S. 4813790) [hereinafter Frankel].

EP, Zaragoza and JP disclose the device as stated above in paragraph 2.

They do not explicitly state that the device has embossed portions as stated in claim 2.

Frankel discloses a device wherein symmetrical portions (embossed portions) are provided on all sides (including opposite sides) of a flexible covering for a better finger grip.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by EP, Zaragoza and JP, so as to add embossed portions, as taught by Frankel, so as to provide the user with a better grip, in order to make it easier and more convenient to hold the device.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP, Zaragoza and JP as applied to claims 1, 4 above, and further in view of Takagi.

EP, Zaragoza and JP disclose the device as stated above in paragraph 2.

They do not teach an inner casing made of a transparent material, as stated in claim 3.

Takagi teaches a transparent inner case 2, a transparent display window formed in the inner casing to view LCD.

Art Unit: 2859

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device, disclosed by EP, Zaragoza and JP, so as to make the inner casing of a transparent material, as taught by Takagi, so as to provide the operator with a clear inside of the thermometer, when the cover is removed for repair of the thermometer.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (571) 272-2253 Monday through Friday 8:00 to 4:00 ET.

GKV

Gail Verbitsky

Primary Patent Examiner, TC 2800



April 05, 2004